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8

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/577,657 | 05/25/00 | MIZUNO | M 029430-454 |

021839 HM12/0108
BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA VA 22313-1404

EXAMINER

KUSELIK, A

| ART UNIT | PAPER NUMBER |
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1638

DATE MAILED:

01/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



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|---------------------------------|-------------|---------------------------------------------------|---------------------|
| APPLICATION NO./ CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR / PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
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| EXAMINER |
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| ART UNIT | PAPER |
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. §§ 1.821-1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Applicant must comply with the requirements of the sequence rules (37 CFR 1.821 - 1.825) before the application can be examined under 35 U.S.C. §§ 131 and 132.

APPLICANT IS GIVEN 30 days FROM THE DATE OF THIS LETTER WITHIN WHICH TO COMPLY WITH THE SEQUENCE RULES, 37 C.F.R., §§ 1.821-1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 C.F.R. § 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 C.F.R. § 1.136. In no case may an applicant extend the period for response beyond the six month statutory period. Direct the response to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the response.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik whose telephone number is (703) 308-5059. The examiner can normally be reached on Monday through Friday, 8:15 am - 4:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell can be reached at (703) 308-4310. The fax number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180-163 f
A. O'Connell ? 20

Notice to Comply

Application No.

09/577,657

Examiner

Anne R. Kubelik,

Applicant(s)

MIZUNO ET AL.

Art Unit

1638

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).
- ☐ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☒ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☐ 7. Other:

Applicant Must Provide:

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

PatentIn Software Program Support

Technical Assistance.....703-287-0200

To Purchase PatentIn Software.....703-306-2600

PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR REPLY

Raw Sequence Listing Error Summary

ERROR DETECTED SUGGESTED CORRECTION

SERIAL NUMBER: 09/577,657

ATTN: NEW RULES CASES: PLEASE DISREGARD ENGLISH "ALPHA" HEADERS, WHICH WERE INSERTED BY PTO SOFTWARE

- 1 _____ Wrapped Nucleics The number/text at the end of each line "wrapped" down to the next line.
This may occur if your file was retrieved in a word processor after creating it.
Please adjust your right margin to .3, as this will prevent "wrapping".
- 2 _____ Wrapped Aminos The amino acid number/text at the end of each line "wrapped " down to the next line.
This may occur if your file was retrieved in a word processor after creating it.
Please adjust your right margin to .3, as this will prevent "wrapping".
- 3 _____ Incorrect Line Length The rules require that a line not exceed 72 characters in length. This includes spaces.
- 4 _____ Misaligned Amino Acid The numbering under each 5th amino acid is misaligned. This may be caused by the use of tabs
Numbering between the numbering. It is recommended to delete any tabs and use spacing between the numbers.
- 5 _____ Non-ASCII This file was not saved in ASCII (DOS) text, as required by the Sequence Rules.
Please ensure your subsequent submission is saved in ASCII text so that it can be processed.
- 6 _____ Variable Length Sequence(s) _____ contain n's or Xaa's which represented more than one residue.
As per the rules, each n or Xaa can only represent a single residue.
Please present the maximum number of each residue having variable length and
indicate in the (ix) feature section that some may be missing.
- 7 _____ PatentIn ver. 2.0 "bug" A "bug" in PatentIn version 2.0 has caused the <220>-<223> section to be missing from amino acid
sequence(s) _____. Normally, PatentIn would automatically generate this section from the
previously coded nucleic acid sequence. Please manually copy the relevant <220>-<223> section
to the subsequent amino acid sequence.
- 8 _____ Skipped Sequences Sequence(s) _____ missing. If intentional, please use the following format for each skipped sequence:
(OLD RULES) (2) INFORMATION FOR SEQ ID NO:X:
 (i) SEQUENCE CHARACTERISTICS:(Do not insert any headings under "SEQUENCE CHARACTERISTICS")
 (xi) SEQUENCE DESCRIPTION:SEQ ID NO:X:
 This sequence is intentionally skipped

Please also adjust the "(iii) NUMBER OF SEQUENCES:" response to include the skipped sequence(s).
- 9 _____ Skipped Sequences Sequence(s) _____ missing. If intentional, please use the following format for each skipped sequence.
(NEW RULES) <210> sequence id number
 <400> sequence id number
 000
- 10 _____ Use of n's or Xaa's Use of n's and/or Xaa's have been detected in the Sequence Listing.
(NEW RULES) Use of <220> to <223> is MANDATORY if n's or Xaa's are present.
In <220> to <223> section, please explain location of n or Xaa, and which residue n or Xaa represents.
- 11 _____ Use of <213>Organism Sequence(s) _____ are missing this mandatory field or its response.
(NEW RULES)
- 12 _____ Use of <220>Feature Sequence(s) _____ are missing the <220>Feature and associated headings.
(NEW RULES) Use of <220> to <223> is MANDATORY if <213>ORGANISM is "Artificial" or "Unknown"
 Please explain source of genetic material in <220> to <223> section.
 (See "Federal Register," 6/01/98, Vol. 63, No. 104, pp. 29631-32) (Sec. 1.823 of new Rules)
- 13 _____ PatentIn ver. 2.0 "bug" Please do not use "Copy to Disk" function of PatentIn version 2.0. This causes a corrupted
file, resulting in missing mandatory numeric identifiers and responses (as indicated on raw sequence listing).
Instead, please use "File Manager" or any other means to copy file to floppy disk.

PAGE: 1

RAW SEQUENCE LISTING
PATENT APPLICATION US/09/577,657

DATE: 06/13/2000
 TIME: 17:01:56

Input Set: I577657.RAW

This Raw Listing contains the General
 Information Section and those Sequences
 containing ERRORS.

Does Not Comply
 Corrected Diskette Needed

1 <110> MITSUI CHEMICALS, INC.
 2 <120> Gene Encoding Caffeine Synthesis System Associated Enzyme
 3 and Use thereof
 4 <130>
 5 <150> JP 146358/1999
 6 <151> 1999-05-26
 7 <160> 21

W--> OK

*Suggestion:
 Consult new
 sequence rules for
 proper format.*

*All items 5
 on Error Summary
 sheet*

ERRORED SEQUENCES FOLLOW

8 <210> 5
 9 <211> 19
 10 <212> DNA
 E--> 11 <213> ← *mandatory number identifier and response needed*
 12 <400> 5 *(why were these in upper-case letters in submitted file) (see circled portion of*
 E--> 13 ttyatgaaym giggigarg 19 *(see p. 5) item 12 in Error Summary*

14 <210> 6
 15 <211> 19
 16 <212> DNA
 E--> 17 <213> ← *is invalid for use in the sequence*
 18 <400> 6 *mandatory number identifier and response*
 19 caaaagggtc agtgctgca 19 *sheet if response is Artificial Sequence or Unknown*

20 <210> 7
 21 <211> 17
 22 <212> DNA
 E--> 23 <213> ← *same error*
 24 <400> 7
 25 atgaccatga ttacgcc 17

26 <210> 8
 27 <211> 20
 28 <212> DNA
 E--> 29 <213> ← *same*
 30 <400> 8
 31 gccggtacct ttctggggcc 20

32 <210> 9
 33 <211> 22
 34 <212> DNA
 E--> 35 <213> ← *same*

PAGE: 2

RAW SEQUENCE LISTING
PATENT APPLICATION US/09/577,657DATE: 06/13/2000
TIME: 17:01:56

Input Set: I577657.RAW

36 <400> 9
37 ccgctgcgtt aagagcttga ag 22

38 <210> 10
39 <211> 21
40 <212> DNA
E--> 41 <213> *same*
42 <400> 10
43 gccaaacact ggaacttcag g 21

44 <210> 11
45 <211> 23
46 <212> DNA
E--> 47 <213> *same*
48 <400> 11
49 ccattgaggc cacttggtgc gtg 23

50 <210> 12
51 <211> 22
52 <212> DNA
E--> 53 <213> *same*
54 <400> 12
55 ggctgtcgt ctgaggttat tg 22

56 <210> 13
57 <211> 22
58 <212> DNA
E--> 59 <213> *same*
60 <400> 13
61 cagcaatggc catagctaat ag 22

62 <210> 14
63 <211> 22
64 <212> DNA
E--> 65 <213> *same*
66 <400> 14
67 ccgctgcgtt aagagcttga ag 22

68 <210> 15
69 <211> 21
70 <212> DNA
E--> 71 <213> *same*
72 <400> 15
73 gccaaacact ggaacttcag g 21

74 <210> 16
75 <211> 23
76 <212> DNA
E--> 77 <213> *same*
78 <400> 16

PAGE: 3

RAW SEQUENCE LISTING
PATENT APPLICATION US/09/577,657DATE: 06/13/2000
TIME: 17:01:56

Input Set: I577657.RAW

79 ccattgaggc cacttggtgc gtg 23

80 <210> 17

81 <211> 22

82 <212> DNA

E--> 83 <213>

84 <400> 17

85 ggccctgtcgt ctgaggttat tg 22

86 <210> 18

87 <211> 17

88 <212> DNA

E--> 89 <213>

90 <400> 18

91 gccatggttt acgcgca 17

92 <210> 19

93 <211> 20

94 <212> DNA

E--> 95 <213>

96 <400> 19

97 cgcccatgga aagaccccg 20

98 <210> 20

99 <211> 21

100 <212> DNA

E--> 101 <213>

102 <400> 20

103 tgatatcact gctgtggcag c 21

104 <210> 21

105 <211> 21

106 <212> DNA

E--> 107 <213>

108 <400> 21

109 aaaatttcatt gttcaacttc t 21

Input Set: I577657.RAW

Line ? Error/Warning

Original Text

| Line | Error/Warning | Original Text |
|------|-------------------------------------------|-------------------------|
| 4 | W Response to "File Reference" is Missing | |
| 11 | E Response to "Organism" is Missing | |
| 13 | E Wrong Nucleic Acid Designator | ttYatgaaYM gIggIgaRg 19 |
| 13 | E Wrong Nucleic Acid Designator | ttYatgaaYM gIggIgaRg 19 |
| 17 | E Response to "Organism" is Missing | |
| 23 | E Response to "Organism" is Missing | |
| 29 | E Response to "Organism" is Missing | |
| 35 | E Response to "Organism" is Missing | |
| 41 | E Response to "Organism" is Missing | |
| 47 | E Response to "Organism" is Missing | |
| 53 | E Response to "Organism" is Missing | |
| 59 | E Response to "Organism" is Missing | |
| 65 | E Response to "Organism" is Missing | |
| 71 | E Response to "Organism" is Missing | |
| 77 | E Response to "Organism" is Missing | |
| 83 | E Response to "Organism" is Missing | |
| 89 | E Response to "Organism" is Missing | |
| 95 | E Response to "Organism" is Missing | |
| 101 | E Response to "Organism" is Missing | |
| 107 | E Response to "Organism" is Missing | |

Input Set: I577657.RAW

Line Original Text

Corrected Data

13 ttYatgaaYM gIggIgaRg 19

ttyatgaaym giggigarg 19

why are some letters in upper-case? All should be lower-case letters